UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,232	09/18/2001	Todd Mark Kelsey	ROC920010197US1	8310

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EXAMINER
HANG, VU B

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/955,232	KELSEY, TODD MARK
	Examiner	Art Unit
	Vu B. Hang	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 September 2006</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-33</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>11-33</u> is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>18 September 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   Paper No(s)/Mail Date. _____.

3)☐ Information Disclosure Statement(s) (PTO/SB/08)   5)☐ Notice of Informal Patent Application

     Paper No(s)/Mail Date _____.   6)☐ Other: _____.

DETAILED ACTION

- This office action is responsive to the following communication: Amendment filed on 09/25/2006.

- New **Claim 33** have been entered and made of record. **Claims 1-33** are pending in the application.

Response to Arguments

1.   Applicant's arguments filed 09/25/2006 have been fully considered but they are not persuasive. Regarding **Claim 1**, the applicant argues that the cited references, Simpson et al. (US Pub. 2003/0011801 A1) and Yu (US Patent 6,707,568 B1), fail to teach or suggest all of the claimed limitations to establish a prima facie case of obviousness. The examiner disagrees for the following reasons. Simpson teaches the use of print options in accordance to the characteristics of the print request (see paragraph [0007]) and using the print options to transform the printable documents in accordance to the print request (see paragraph [0021]). Simpson further teaches the using the print options to modify the printable contents (see paragraphs [00026-0027]). Yu teaches retrieving user-specified print option parameters and transforming the printable contents in accordance to the user-specified print options (see Fig.4B (S94), Col.2, Line 18-24 and Col.4, Line 45-58). Yu further teaches the use of unique user-specified formatting on the print data as print options (see Col.1, Line 20-22 and Col.1, Line 30-38). Therefore, both cited references suggest all of the claimed limitations, and are combinable because they teach the use of print options for printing printable contents in a user-specified manner.

2.   The applicant also argues that Yu does not teach or suggest "removing a portion of the printable content in order to avoid printing the removed printable content on the printed output", as claimed in the amended **Claim 1**. The examiner disagrees for the following reasons. Yu teaches the use of unique user-specified formatting as print options to print the printable contents into a specific format (see Col.1, Line 20-22 and Col.1, Line 30-38). It would have been obvious for one skilled in the art to apply to the formatting a means for removing unwanted printable contents from the print data. The motivation would be to achieve a specific formatting for the print data to be printed.

3.   The applicant further argues that Simpson fails to disclose applying print options without regard to the transformation of printable contents. With further review of the reference, the examiner has found that Simpson discloses the use of print options in accordance to the characteristics of the print request (see paragraph [0007]) and using the print options to transform the printable documents in accordance to the print request (see paragraph [0021]). Simpson further discloses the using the print options to modify the printable contents (see paragraphs [00026-0027]).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claim 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al.

(US Pub. 2003/0011801 A1) in view of Yu (US Patent 6,707,568 B1).

6.   Regarding **Claim 1**, Simpson discloses a method for controlling printable content from

textual and graphical sources (see Fig.9, paragraph [0005] and paragraph [0007]), comprising:

monitoring for a print request (see Fig.9 (502) and paragraph [0068]); matching a print file with

stored identification data (see paragraph [0020] and paragraph [0065]); and transforming the

printable content in the print file in accordance with the stored print options (see paragraph

[0021], paragraph [0039] and paragraphs [00026-0027]). Simpson, however, fails to disclose

intercepting the print file generated by the driver from the print request. Yu, however, discloses

intercepting the print file generated by the print driver and transforming the print file in

accordance to with the stored print options (see Fig.3A, Fig.4B and Col.3, Line 46-52), whereby

the transformed print file produces a printed output different from a printed output that would

have been produced by the print file generated by the print driver (see Fig.3A and Col.3, Line

46-52). Yu further teaches the use of unique user-specified formatting as print options to print

the printable contents into a specific format (see Col.1, Line 20-22 and Col.1, Line 30-38). It

would have been obvious for one skilled in the art to apply to the formatting a means for

removing unwanted printable contents from the print data.

7.   Simpson and Yu are combinable because they are from the same field of invention,

namely print option configuration methods. At the time of the invention, it would have been

obvious for one skilled in the art to include to a print option configuration method a means for

intercepting the print file generated by the driver and transforming the print file in accordance to

a stored print option data. The motivation would be to eliminate the need to install a new print

driver in cases where the current driver does not support the printing options specified by the

user or an application. The installation of a new print driver would cause valuable time, energy

and money to be consumed. It is further obvious for one skilled in the art to apply to the

formatting a means for removing unwanted printable contents from the print data. The

motivation would be to achieve a specific formatting for the print data to be printed.

8.   Regarding **Claims2,** Simpson further discloses that the configuration data file is

configured to store the identification data and print options (see Fig.5 and Fig. 9 (510), the print

monitoring module is configured for monitoring the print request (see Fig.9 (502)), and

transformation program module is configured for transforming the print file (see paragraph

[0021] and paragraph [0039]).

9.   Regarding **Claim 3,** Simpson further discloses identifying identification data in the print

request and comparing the identification data in the print request to the stored identification data

in a currently selected print configuration data file (see paragraph [0020] and paragraph [0065]).

10.   Regarding **Claim 4,** Simpson further discloses printing the transformed print file to an

output device (Fig.2 (174)).

11.   Regarding **Claim 5,** Simpson and Yu disclose the method of Claim 1 but fail to disclose

selecting an output device from a group consisting of a printer, copier and scanner. At the time of

the invention, it would have been obvious for one skilled in the art to use a multifunction

peripheral device that has a printing, copying and scanning function. The motivation would be to

provide multiple options for producing the final print products.

12.   Regarding **Claim 6,** Simpson further discloses that the stored data and the print options

are user configured (see Fig.5 and paragraph [0031]).

13.   Regarding **Claim 7**, Simpson further discloses that prior to the monitoring step, receiving the identification data and the print options from a graphical user interface generated by a print option-formatting module (see Fig.5 and paragraph [0031]).

14.   Regarding **Claim 8**, Simpson further discloses selecting a current print configuration data file from a listing of at least one print configuration data file (see Fig.10 (534,540) and paragraph [0070]).

15.   Regarding **Claim 9**, Yu further discloses that the print file is a spooled print file (see Fig.3A and Col.3, Line 46-52). At the time of the invention, it would have been obvious to have the print file as spooled file. The motivation would be to perform print data processing and transformation at the printing device.

16.   Regarding **Claim 10**, Yu further discloses that the print driver configures the print file prior to the transformation step (see Fig.3A and Col.3, Line 46-52). At the time of the invention, it would have been obvious to have the print driver configure the print file prior to the transformation step. The motivation would be to keep the print driver from being involved in the transformation process. This would eliminate the need for a new print driver to be installed.

Allowable Subject Matter

17.   **Claims 11-33 are allowed.**

18.   The following is an examiner's statement of reasons for allowance:

19.   Regarding **Claims 11 and 19**, in the examiner's opinion, it would not have been obvious to have the inventions, as claimed, further include the features of "transforming the printable content in the print file in accordance to print options whereby the transformed print file

produces a printed output different from a printed output that would have been generated by the

printer driver, and wherein the printable content that is transformed is selected from at least one

of banners, advertisements, solid background, user highlighted content, and any combination

thereof". The closes prior art, cited Simpson et al. (US Pub. 2003/0011801 A1) and Yu (US

Patent 6,707,568 B1), only teach controlling printable content by monitoring for a print request

matching a print file with stored identification data, intercepting the print file generated by the

print driver and transforming the print file in accordance to with the stored print options, and

transforming the print file in accordance with the stored print options. Neither Simpson nor Yu

teach "transforming the printable content in the print file in accordance to print options whereby

the transformed print file produces a printed output different from a printed output that would

have been generated by the printer driver, and wherein the printable content that is transformed is

selected from at least one of banners, advertisements, solid background, user highlighted content,

and any combination thereof", as claimed in Claims 11 and 19. Therefore, because of these

features, **Claims 11 and 19**, along with their dependent **Claims 12-18 and 20-33**, are rendered

allowable.

Conclusion

20.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

21.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

22.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Vu B. Hang whose telephone number is (571) 272-0582. The

examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

23.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

24.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vu Hang
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PRIMARY EXAMINER